

REMARKS

Initially, please note Counsel's Change of Address, through the Change of Correspondence Address document included herein.

Remarks Regarding Office Response to Affiant Evidence

In Applicant's Response to August 24, 2005 Office Action, the Applicant submitted the Affidavit of Yashvinder Sabharwal, a person skilled in the art who is a PhD in Optical Engineering. The Office has rejected the opinions of Dr. Sabharwal, namely, his opinion that "The Kasulis reference discloses the use of mirrors positioned at angles to the interior surface of the fireplace or firebox, which will create an optical view that is different in perspective from the original three dimensional construction of the fireplace or firebox" and "The present invention, in contrast to the Kasulis disclosure, teaches the positioning of the reflective material to be substantially parallel to the interior surface of the fireplace or firebox, maintaining an optical view consistent with the predetermined interior surface of the fireplace, firebox or firechamber". As basis for the rejection, the Office states that *at least three reflectors* (76, 86, 86 of Kasulis figures 8 and 9) are arranged, attached, and aligned parallel to the respective fireplace walls.

Because the "*at least three reflectors*" are reasoned by the Office to be aligned parallel to the Kasulis disclosure, the Office has determined that the Kasulis would not provide "a three-dimensional view consistent with a pre-determined interior surface of the firebox", and concluded that except for Dr. Sabharwal's evidence, no factual evidence is presented that Kasulis would not provide a three-dimensional view. As discussed below (and previously), this position is factually incorrect.

It is clear that Dr. Sabharwal's expert opinion must be considered in light of the nature of the matter sought to be established, the strength of any opposing evidence, the expert's interest in the outcome of the case and the presence or absence of factual support for the expert's opinion. TMEP § 716.01(c) (citations omitted). Clearly, the nature of the matter to be established by Dr. Sabharwal is that due to the specific structure recited in the Kasulis disclosure, it would not result a structure where each light reflective material couples substantially parallel to the firebox's pre-determined interior surface to provide a three-dimensional view consistent with the pre-determined interior surface of the firebox. Further, outside of reliance on the Kasulis reference, the Office provides no other evidence to overcome Dr. Sabharwal's opinion. Dr. Sabharwal has no interest in the outcome of this matter. Finally, Dr. Sabharwal's opinion clearly states forth, in detail with recitation to the portions of the Kasulis patent, the factual evidence to support his opinion.

In this case, the Office admittedly relies on "*at least three*" of the Kasulis reflectors to reason that such arrangement will result in "maintaining an optical view consistent with the predetermined interior surface of the fireplace, firebox or fire chamber". This is factually incorrect. As seen in the Kasulis reference, the firebox is constructed as generally square surfaces (the firebox interior surfaces are not specifically labeled in the Kasulis reference, but can be generally defined through analogy by arrows from elements 10, 20 and 46). While "*at least three*" reflectors are oriented substantially parallel to *three* of the firebox's interior surface, the "fourth" Kasulis reflector at the back, rear surface of the firebox clearly is not oriented substantially parallel to the firebox's rear interior surface. In direct contrast, the Kasulis has two separate viewable surfaces 76 and 78, wherein viewable surface 78 has a separate and different angular surface plane than that the Kasulis rear interior surface of the firebox (*see* Kasulis Fig. 8). Kasulis specifically states that this rear viewable surface is a "mirror in an orientation offset from the vertical within a fireplace behind the fire" (*see* Kasulis, Col. 2, *ll.* 5 – 6, 12 -13; Col. 3, *l.* 49, *ll.* 56 – 57) or is otherwise an "angled mirror" (Kasulis, Col. 5, *ll.* 61 – 62). As such, structurally, the Kasulis reference does not read on the

present invention because the Kasulis reference can never provide a three-dimensional view consistent with the pre-determined interior surface of the firebox because one of the Kasulis mirrors is oriented off-set from the interior surface of the firebox. Dr. Sabharwal's Affidavit supports this position (*See* Sabharwal Affidavit, ¶ 10), and the Office has not provided any evidence to contradict this position.

Instead, the Office is reading disclosure into Kasulis that does not exist, which is impermissible. Moreover, while the Office relies on Kasulis' disclosure of three reflectors to reject the present application under Section 102, the Office is ignoring the recitation in the present claims that each light reflective material is parallel to the firebox's interior surface, which provides a three-dimensional view consistent with the interior surface of the firebox – the Kasulis patent will never achieve such a view because one of the Kasulis' mirrors is not parallel to the rear firebox interior surface.

Additionally, because the Kasulis reference does not either directly or inherently read on any claim in the present invention, and because the Kasulis reference does not structurally comport with the recitations of Claims 1, 11 and 17, the Office cannot reject the present invention under Section 102. ("Under 35 U.S.C. 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim" (*Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997)).

Because the Kasulis patent fails to disclose every limitation of the present independent claims identically pursuant to 35 U.S.C. § 102, the Kasulis patent fails to anticipate the rejected independent claims (i.e., Claims 1, 11 and 17), and those claims which depend on these claims (i.e., claims 2-6, 8-10, 12-16 and 18-20).

Reconsideration is respectfully requested.

Rejections Pursuant to 35 USC § 102

Without adding any additional commentary or reasoning, the Office has apparently reiterated its Section 102 rejections from prior office actions (*see* 2/8/06 Office Action, pp. 3 – 8). The only prior art relied on by the Office to support its Section 102 rejection is the Kasulis reference. The Applicant is not required to respond to the other prior art references recited (e.g., Greenspan, Shumaker, Pledger, Butterfield, Hiser, Fleming), because the Office has not relied on these references to support its Section 102 rejections, and because clearly, such references do not disclose every limitation recited in the pending claims. Any reliance on any one of these individual references to support a Section 102 rejection would be improper.

Rejection Pursuant to 35 USC § 103

The Office has again reiterated its Section 103 rejection from a prior office action. *See* Office Action, pp. 9 – 10). The Applicant has previously responded to this rejection, namely that it follows that since Claim 8 is dependant upon Claim 3, Claim 3 is dependant upon Claim 1, and because the Office has not rejected Claim 1 under Section 103, then Claim 8 cannot be rejected under Section 103. Also, since Claim 9 is dependant upon Claim 3, Claim 3 is dependant upon Claim 1, and Claim 1 is not rejected under Section 103, then Claim 9 must similarly stand as not rejected under Section 103. As such, the Applicant cannot respond to the Office's Section 103 prior art reasoning and rejections because Claims 8 and 9 must stand as not being rejected, since they are dependant upon a non-rejected claim (Claim 1) pursuant to Section 103.

This is the second time the Applicant has made this response without any commentary from the Office (*see* e.g., "Response to April 13, 2005 Office Action" (filed June 8, 2005) and "Response to August 24, 2005

Office Action" (filed Dec. 23, 2005). Because the Office has not overcome this response, it is deemed accepted by the Office.

Withdrawal of this continued rejection (without any further foundation from the Office to support this rejection) is respectfully requested.

Conclusion

In light of the foregoing amendments and remarks, the Applicant respectfully requests the Office to withdraw the pending objections and rejections, and allow the present application to issue. The undersigned would welcome a phone call from the Office to expedite the resolution of this application. A return postcard is attached, which the Applicant requests the Office to stamp and mail to the Applicant. Finally, the Applicant further submits a Petition for Two Months Extension of Time (extending the time from May 8, 2006 to July 8, 2006), along with a check for \$225.00 to cover the petition fee. While the present Response is being filed in accordance with 37 CFR 1.10 express mail on July 10, 2006, the date of July 8, 2006 fell on a Saturday, thereby allowing the present response to be filed the following Monday.

Respectfully submitted,

Date: July 10, 2006

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